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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,107	09/26/2003	Denny Jaeger	3984/CIP/CON	7729

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EXAMINER

CHANG, KENT WU

ART UNIT	PAPER NUMBER
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2629

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,107

Applicant(s)

JAEGER, DENNY

Examiner

Kent Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,700,567 in view of Katabami (US Patent No.5,528,002).

The device recited in claims 1-10 of the current application differs to the device recited in claims 1-12 of U.S. Patent No. 6,700,567 in that it receives light from its surrounding environment rather than RF energy. Katabami teaches using a photocell in a stylus to receive light from its surrounding environment so as to power the stylus. Therefore, it would have been obvious for one of ordinary skill in the art to use a photocell in a stylus to receive light from its surrounding environment as taught by Katabami in the device as recited in claims 1-12 of

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U.S. Patent No. 6,700,567 so as to power the stylus conveniently as suggested by Katabami.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 1, 2, 8, 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Katabami (US Patent No.5,528,002).

Consider claim 1. Katabami teaches a powered input device for a touch screen system and display screen that includes an electronic signaling circuit in the input device, the improvement comprising: at least one photovoltaic cell supported by said powered input device; said at least one photovoltaic cell connected to power said electronic signaling circuit; said input device being free of any mechanical connection to said touch screen system; said at least one photovoltaic cell being disposed to receive light from the surrounding environment. Since the input device is used near the display screen and the light in its surrounding environment includes light generated by the screen, therefore, the input device is powered at least in part by the light emitted by said display screen (column 20 lines 39-57).

Consider claim 2. The improved powered input device of Katabami, wherein said input device is free of any electrical wire connection to said touch screen system (cordless pen 5, column 6 lines 61-66).

Consider claim 8. The improved powered input device of Katabami, further including means for storing electrical energy generated by said at least one photovoltaic cell (column 20 lines 39-57).

As to claim 9, see rejection of claim 2.

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7. Claims 3-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katabami (US Patent No.5,528,002).

Katabami teaches a powered input device for a touch screen system and display screen that includes an electronic signaling circuit in the input device, the improvement comprising: at least one photovoltaic cell supported by said powered input device; said at least one photovoltaic cell connected to power said electronic signaling circuit; said input device being free of any mechanical connection to said touch screen system; said at least one photovoltaic cell being disposed to receive light from the surrounding environment. Since the input device is used near the display screen and the light in its surrounding environment includes light generated by the screen, therefore, the input device is powered at least in part by the light emitted by said display screen (column 20 lines 39-57). It would have been obvious for one of ordinary skill in the art at the time of the invention to use transparent material, including a transparent pen tip, to enclose the photovoltaic cell so as to maximize the light being received by the photovoltaic cell from every direction.

Consider claim 4. It would have been obvious for one of ordinary skill in the art at the time of the invention to include a barrel in the device of Katabami so as to enable easy grasping of the pen by the user. On page 8 lines 14-15, applicant admitted that it is known to have a barrel in a conventional pen for being manually grasped of the pen.

Consider claim 10. The solar cell in the device of Katabami provides sufficient power to the pen and the rechargeable battery (see column 20 lines 43-53). Obviously, the rechargeable battery is used as a back up power source but could have been

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eliminated so as to reduce the number of parts needed for a device with low cost or small size.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lewis et al (US Patent No. 5,294,792); Persidsky (US Patent No. 6,130,666).

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kent Chang whose telephone number is 571-272-7667. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz, can be reached at 571-272-3638.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

571-273-8300

Hand-delivered responses should be brought to the Customer Service Window, now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kent Chang
Primary Examiner
Art Unit 2629 Division 2629

kc

5/29/06